

REMARKS

Applicant respectfully requests reconsideration of this application.
Claims 1-14 are pending. No claims have been amended, canceled, or added.

The Examiner has rejected claims 1 and 6-9 under 35 U.S.C. §103(a) as being unpatentable over Johnson (US 3,778,662) in view of Roberts (US 4,633,128). Applicant respectfully traverses the rejection. Claim 1 sets forth:

a first electrode comprising a first **rod** having a first end and a second end, the first end being mounted in the first cap; and
a second electrode comprising a second **rod** having a first end and a second end, the first end of the second rod being mounted in the second cap.

(Claim 1, emphasis added).

As admitted in the Office Action, Johnson fails to disclose a first electrode comprising a first rod nor a second electrode comprising a second rod. However, the Office Action then states that Roberts discloses a first electrode comprising a first rod and a second electrode comprising a second rod. The Office Action further argues that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the electrode structure of Roberts into the lamp of Johnson in order to provide a simpler, more durable electrode structure. Applicant respectfully disagrees with the Office Action.

According to Johnson, the lamp includes discharge electrodes 19, which is in the shape of a coil, to emit thermionically upon excitation. The discharge electrodes

19 emit current over their surface, measured in units of current per unit of surface

Inventor(s): Roberts

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area (A per cm²). (Johnson, col. 4, ln. 37-45) Note that the object of Johnson is to provide high intensity fluorescent lamps (Johnson, col. 1, ln. 50-53). Johnson further discloses that for discharge currents in excess of 20 A/cm², "it is *desirable* that high temperature arc cathodes such as the *coiled-coil* or *double coiled* tungsten arc electrode" be utilized (Johnson, col. 4, ln. 64-68; emphasis added). The use of coiled-coil or double coiled electrode provides greater surface area, thus greater current, which is important in providing high intensity fluorescent lamps. In contrast, modifying Johnson by replacing the coiled electrode with a rod-shaped electrode significantly reduces the surface area of the discharge electrode 19 and leads to lower current, and hence, lower intensity, which is against the object of Johnson.

As taught by the Federal Circuit, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 8733 F.2d 900 (Fed. Cir. 1984). Since the proposed modification to Johnson to replace the coiled electrode with a rod-shaped electrode would reduce the surface area of the electrode and leads to lower current, and hence, lower intensity, the modified fluorescent lamp would be unsatisfactory for its intended purpose of providing high intensity. As such, under current case law, there is no motivation to make the proposed modification. For at least this reason, claim 1 is patentable over Johnson in view of Roberts. Withdrawal of the rejection is respectfully requested.

Claims 6-9 depend, directly or indirectly, from claim 1. Thus, claims 6-9 are patentable over Johnson in view of Roberts for at least the reason discussed above with respect to claim 1. Withdrawal of the rejection is respectfully requested.

The Examiner has rejected claims 2-5 and 10-14 under 35 U.S.C. §103(a) as being unpatentable over Johnson and Roberts as applied to claim 1 above, and further in view of Waymouth (US 3,728,004). Applicant respectfully traverses the rejection.

For the reason discussed above with respect to claim 1, there is no motivation for one of ordinary skill in the art to combine the references at the time of the invention. Thus, claim 10 is patentable over Johnson in view of Roberts and Waymouth for at least this reason. Withdrawal of the rejection is respectfully requested.

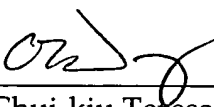
Claims 2-5 and 11-14 depend, directly or indirectly, from claims 1 and 10, respectively, and thus, include all the limitations set forth in claim 1. For at least the reason discussed above with respect to claims 1 and 10, there is no motivation for one of ordinary skill in the art to combine the references at the time of the invention. Thus, claims 2-5 and 11-14 are patentable over Johnson in view of Roberts and Waymouth. Withdrawal of the rejection is respectfully requested.

Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call C. Teresa Wong at (408) 720-8300.

Pursuant to 37 C.F.R. §1.136(a)(3), Applicant hereby requests and authorizes the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. §§1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,
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